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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,797	01/19/2000	ANDREW JOHNSON	A-68362/DJB	4776

23735 7590 12/01/2006

DIGIMARC CORPORATION  
9405 SW GEMINI DRIVE  
BEAVERTON, OR 97008

EXAMINER
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KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/367,797

Applicant(s)

JOHNSON ET AL.

Examiner

Paula W. Klimach

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 53-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 33-52 is/are allowed.
- 6) ☒ Claim(s) 1, 15 and 27 is/are rejected.
- 7) ☒ Claim(s) 2-14, 16-26 and 28-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/23/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of 1-52 in the reply filed on 09/11/06 is acknowledged. The traversal is on the ground(s) that the spectral power density being flat was not newly introduced. This is not found persuasive because in the previous claims the digital media segmented and the pseudo random function was applied to only the block of data, while in the new claims the pseudo random function performs the flattening of the power spectral density of the data as a whole.

The requirement is still deemed proper and is therefore made FINAL.

### ***Response to Arguments***

Applicant's arguments filed 09/11/06 have been fully considered but they are not persuasive because of following reasons.

The applicant argued that the claims 1, 15, and 27 each produce a useful, concrete, and tangible result. This is not found persuasive. As explained in more detail in the rejection below, the claims may have a concrete result, however the result is not presented in such a way that it may be useful.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1, 15, and 27** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

*In reference to claims 1, 27*, consists solely of executing a mathematical algorithm that is non-statutory subject matter. In the claims 1 and 27 the preamble discloses inserting identification or authentication data into digital media data, however the claim does not finally disclose any identification data being inserted into the media data. Instead the claim discloses applying an inverse pseudo-random function to obtain watermarked digital media data without the step of inserting the identification into the digital data. This causes the claim to be non statutory because it does not make the final result available for use. The calculation of the watermark is an algorithm and therefore under the judicial exception and therefore requires a useful and concrete result. For the result to be useful it must be presented for use for example a calculated value that is displayed.

*In reference to claims 15* claims transforming data and as such manipulates abstract ideas or concepts. The claims lack a useful concrete and tangible result. Although in claim 15 the applicant discloses the extraction of identification or authentication data that is the result indicated by the preamble, however the extraction step does not make the result available for use.

In the case that the claims are amended to overcome the 101 rejection, the above claims will be allowable.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PWK  
Wednesday, November 22, 2006

A handwritten signature in black ink, appearing to read 'Kim Vu', with a stylized, cursive script.

**KIM VU**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2**